

## REMARKS

Applicant, by the amendments presented above and the arguments presented below, has made a concerted effort to present claims which clearly define over the prior art of record, and thus to place this case in condition for allowance. Claims 1-31, 37-41 are currently pending. Claims 32-36 have been cancelled. Claim 37 has been allowed. Claims 39-41 are newly added.

### *Drawings*

The Examiner objected to the drawings under 37 CFR 1.83(a) on the basis that they fail to show an insert which is permanently fastened into a counterbore as described in the specification.

The Examiner further objected to the drawings under 37 CFR 1.83(a) on the basis that the drawings must show every feature of the invention specified in the claims and, because the insert being fastened into an axial counterbore is claimed in claims 8 and 24, this feature must be shown or the features canceled from the claims.

In view of the foregoing objections, Applicant has added new FIGURE 12 to the drawings and has amended FIGURE 11. FIGURE 12 is a cross-sectional view of FIGURE 11 taken along line 12-12 of FIGURE 11. FIGURE 12 clearly illustrates the axial counterbore of the body of the punch and further clearly illustrates the insert being fastened therein.

Applicant states that the amendment to FIGURE 11 and the addition of FIGURE 12 does not present new matter to the application as the application clearly has support for the body of the punch to have an axial counterbore therein and that the insert is fastened to the body of the punch in the axial counterbore. Support for same can be found in the application at the

following places: page 4, lines 7-8; page 14, lines 18-21; page 15, lines 7-16; and page 15, line 21 to page 16, line 10.

Applicant has attached hereto a "Replacement Sheet" which illustrates the amended FIGURE 11 and the new FIGURE 12. The "Replacement Sheet" replaces the drawing sheet which previously only has FIGURE 11 illustrated thereon.

### ***Specification***

In view of the amendment made to FIGURE 11 and in view of the addition of new FIGURE 12, Applicant has amended the specification to include reference to FIGURE 12 and to include reference numerals 705 and 709 for the wall of the passageway 704 and the counterbore of the passageway, respectively, which had previously been referenced as having not been shown. Applicant states that no new matter has been added by the amendments to the specification.

### ***Claim Rejections – 35 U.S.C. §102***

Claims 1-6, 9-11 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 4,830,548 to Kandarian.

Applicant has cancelled claims 1-6 and 9-11 herein and, therefore, considers the rejection of these claims to be moot.

With regard to independent claim 27, Applicant respectfully traverses this rejection. Independent claim 27 requires that the cutting portion of the punch extend from the punch body a predetermined distance in order to "shear" the workpiece. According to Webster's New World College Dictionary, 3<sup>rd</sup> Ed., 1997, "shear", in accordance with the specification of the application, means "to tear or wrench (*off*) by shearing stress". The Kandarian cutting

tool assembly does not “shear” the workpiece. Rather, the Kandarian cutting tool cuts into the workpiece by a drilling, rotating action of the cutting blade. As such, for at least this reason, Applicant states that Kandarian does not disclose each and every element of independent claim 27 and, therefore, Applicant respectfully requests reconsideration and allowance of independent claim 27.

### *Claim Rejections – 35 U.S.C. §103*

Claims 1-8, 12-26 and 38 were rejected under 35 U.S.C. 102(b) as being unpatentable over United States Patent No. 3,683,499 to Robinson in view of United States Patent No. 4,830,548 to Kandarian. Applicant notes that within the Examiner’s explanation of this rejection, reference is further made to the rejection of claims 27-31 and, therefore, Applicant will treat the Examiner’s rejection as having rejected claims 1-8, 12-31 and 38 under 35 U.S.C. 102(b) as being unpatentable over United States Patent No. 3,683,499 to Robinson in view of United States Patent No. 4,830,548 to Kandarian.

Applicant has cancelled claims 1-8 and 12-17 herein and, therefore, considers the rejection of these claims to be moot.

Applicant respectfully traverses this rejection with regard to independent claims 18 and 38. Applicant acknowledges that Robinson discloses a punch body having a bore extending at least partially therethrough, at least one piercing portion, and at least one cutting portion. Applicant, though, states that neither Robinson nor Kandarian discloses an insert member which is removably secured within the bore of the punch body which is configured to center the punch body with the pilot hole of the workpiece, nor which has a bore therethrough which is in communication with the bore of the punch body.

Clearly, Robinson does not disclose or even suggest providing an insert member in the

bore thereof which is configured to center the punch body with the pilot hole of the workpiece nor which has a bore therethrough which is in communication with the bore of the punch body. Robinson is just another example of a number of prior art punches which all have varying configurations for the piercing and cutting/shearing edges thereon, but like all these other prior art punches, Robinson is not concerned with solving the problem of proper alignment of the hole to be punched.

Thus, in view of the foregoing, the Examiner has made an argument to combine the teachings of Kandarian with those of Robinson in order to provide the rejection of independent claims 18 and 38. Kandarian discloses a cutting tool assembly having a pilot holder, a blade and a set screw. The pilot holder is secured at one end thereof to a tool used to rotate the pilot holder and the other end has a bore extending into the pilot hole to a transverse slot provided through the pilot holder. The transverse slot is used for receiving the blade therein. The set screw is threadedly inserted into the bore and against the blade in order to secure the blade to the pilot holder.

Clearly, the combination of Robinson with Kandarian would not provide the punch as claimed in independent claims 18 and 38. The set screw in Kandarian is the only item in either Robinson or Kandarian which is disclosed or suggested to have been removably secured within a bore. The set screw in Kandarian, however, is not configured to center any portion of the Kandarian cutting tool assembly with the pilot hole in the workpiece, rather the set screw in Kandarian is configured only to secure the pilot holder to the blade of the Kandarian cutting tool assembly.

Also, the set screw of Kandarian is not disclosed as having, or even suggested as having, a bore which extends therethrough. As such, one of ordinary skill in the art would not attempt to utilize the set screw of Kandarian in the punch body of Robinson as there is no

bore through the set screw which would allow access to the bore of the punch body by a tool used for manipulating the Robinson punch into punching a hole through a workpiece.

Thus, Applicant states that the combination of Robinson and Kandarian does not disclose or suggest the invention as claimed in independent claims 18 and 38 as there is no need in Robinson for a member, such as a set screw, to be threadedly engaged with the bore thereof in order to secure the blade or cutting portion, as the cutting portion of Robinson is already integrally provided with the punch body. Further, the set screw in Kandarian is not disclosed to have a bore therethrough to allow tools access therethrough. As such, Applicant respectfully requests reconsideration and allowance of independent claims 18 and 38.

As Applicant states that independent claim 18 is now in condition for allowance, Applicant respectfully requests reconsideration and allowance of claims 20-26 as they are all ultimately dependent on independent claim 18. Applicant has made minor amendments to claims 20, 21, 23, 24 and 26 in view of the amendments made to independent claim 18. Applicant has cancelled claim 19 herein.

Applicant respectfully traverses this rejection with regard to independent claim 27. Applicant acknowledges that Robinson discloses a punch body having a bore extending at least partially therethrough, at least one piercing portion, and at least one cutting portion. Applicant, though, states that neither Robinson nor Kandarian discloses a pair of projections extending from the punch body a predetermined distance and positioned opposite of each other and adjacent to the bore of the punch body which are capable of centering the punch body with the pilot hole of the workpiece.

Clearly, Robinson does not disclose or even suggest providing a pair of projections which are capable of centering the punch body with the pilot hole of the workpiece. Robinson is just another example of a number of prior art punches which all have varying

configurations for the piercing and cutting/shearing edges thereon, but like all these other prior art punches, Robinson is not concerned with solving the problem of proper alignment of the hole to be punched.

Thus, in view of the foregoing, the Examiner has made an argument to combine the teachings of Kandarian with those of Robinson in order to provide the rejection of independent claim 27. Kandarian discloses a cutting tool assembly having a pilot holder, a blade and a set screw. The pilot holder is secured at one end thereof to a tool used to rotate the pilot holder and the other end has a bore extending into the pilot hole to a transverse slot provided through the pilot holder. The transverse slot is used for receiving the blade therein. The set screw is threadably inserted into the bore and against the blade in order to secure the blade to the pilot holder.

Clearly, the combination of Robinson with Kandarian would not provide the punch as claimed in independent claim 27. Kandarian does not disclose a pair of projections which are positioned opposite of each other and adjacent to the bore of the punch body. Kandarian, rather, discloses a pilot holder having a bore extending therein from one of the ends thereof. No projections of any kind, much less two such projections, are provided in the Kandarian cutting tool assembly which are positioned opposite of each other and adjacent to the bore extending within the pilot holder. The reason for this is because Kandarian has only provided the bore in the cutting tool assembly as a place for the set screw to be positioned within in order to secure the blade to the pilot holder.

Further, Applicant has amended independent claim 27 to specify that the punch of the invention as claimed in independent claim 27 is a one-piece punch. The combination of Robinson and Kandarian does not disclose or suggest such a structure. Further, by having the projections being a part of the one-piece punch, a cost savings is provided with the punch of

the invention over the prior art punches.

Thus, Applicant states that the combination of Robinson and Kandarian does not disclose or suggest the invention as claimed in independent claim 27. As such, Applicant respectfully requests reconsideration and allowance of independent claim 27.

As Applicant states that independent claim 27 is now in condition for allowance, Applicant respectfully requests reconsideration and allowance of claims 28-31 as they are all ultimately dependent on independent claim 27. Applicant has made minor amendments to claims 28-31 in view of the amendments made to independent claim 27.

#### ***Allowable Subject Matter***

The Examiner indicated that claim 37 was allowed.

#### ***New Claims***

Applicant has added new claim 39. As new claim 39 is ultimately dependent on independent claim 18, which Applicant states is now in condition for allowance, Applicant respectfully requests consideration and allowance of new claim 39.

Applicant has added new claims 40 and 41. As new claims 40 and 41 are ultimately dependent on independent claim 27, which Applicant states is now in condition for allowance, Applicant respectfully requests reconsideration and allowance of new claims 40 and 41.

In view of the above Amendments and Remarks, Applicant respectfully submits that the claims of the application are allowable over the rejections of the Examiner. Should the Examiner have any questions regarding this Amendment, the Examiner is invited to contact one of the undersigned attorneys at (312) 704-1890.

Respectfully submitted,

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